

applicants' claims in their entirety? The answer to this question is that the Patent Office is obligated to examine on the merits all claims that have not been withdrawn from consideration because of the restriction requirement, i.e. claims 7, 23, and 24.

Applicants have the right under U.S. patent law to claim their invention using the limitations that they regard as essential to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met. It is well-established law that **restriction within a single claim cannot be sustained under 35 U.S.C. §121**. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978) at pages 331-332,

“§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be “independent and distinct.” It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis.” (Emphasis in original text.)

Applicants look forward to full examination on the merits for all claims presently under consideration.

In the Office Action, it was alleged that the application does not contain an abstract. This is incorrect. Applicants submitted an abstract with their Preliminary Amendment dated November 14, 2000. Applicants request that this abstract be considered when examining the present application.

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Claims 7, 23 and 24 were rejected under 35 U.S.C. § 112, first and second paragraphs. Specifically, the phrase "and derivatives of said compounds" was found to be problematic. There was also a typographical error in claims 23 and 24. While applicants maintain that the quoted language is fully supported within the meaning of 35 U.S.C. § 112, to expedite prosecution, this language has been removed from the claims. The typographical errors were also corrected.

Reconsideration and withdrawal of all rejections under 35 U.S.C. § 112, first and second paragraphs, is earnestly solicited.

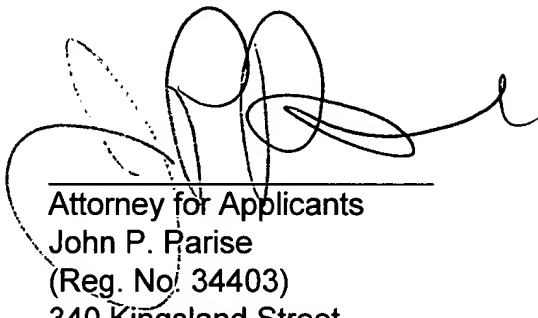
Since the Patent Office has acknowledged that the claimed invention is free of the prior art and all statutorily based rejections have been overcome above, issuance of a Notice of Allowance is solicited.

If a telephone conference would be of assistance in furthering prosecution of the subject application, applicants request that the undersigned attorney be contacted at the number below.

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No fee is required in connection with the filing of this Amendment. If any fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,

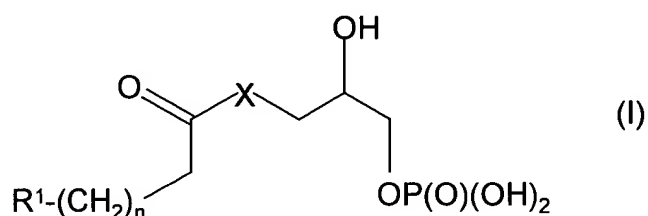
A handwritten signature in black ink, appearing to read 'John P. Parise', is written over a horizontal line. The signature is stylized with large loops and a long trailing flourish.

Attorney for Applicants  
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**VERSION SHOWING CHANGES MADE TO THE TEXT**

-- 7. (Amended) A lysophosphatidyl acid derivative selected from the group consisting of compounds of formula (I)



wherein

R¹ = alkenyl or alkynyl having from 6 to 24 carbon atoms;

n = 0 – 12;

X = oxygen or NH;

the compounds (all-cis-5,8,11, 14)-eicosatetraenoic acid 2-hydroxy-3-phosphonooxypropyl ester; cis-9, cis-12-octadecadienoic acid 2-hydroxy-3-phosphonooxypropyl ester; (all-cis-9,12,15)-octadecatrienoic acid 2-hydroxy-3-phosphonooxypropyl ester; cis-9-octadecenoic acid 2-hydroxy-3-phosphonooxypropyl ester; and erucic acid 2-hydroxy-3-phosphonooxypropylester being excluded, and the physiologically tolerable salts, esters, optically active forms, and racemates of said compounds, and ~~derivatives of said compounds~~, salts, esters, optically active forms and racemates which can be metabolized *in vivo* to yield the corresponding compound of formula (I). –

-- 23. (Amended) The compound of claim 7 which is selected from the group consisting of cis-13-eicosenoic acid 2-hydroxy-3-phosphonooxypropyl ester; ~~(64)~~ (all-cis-7,10,13,16)-docosatetraenoic acid 2-hydroxy-3-phosphonooxypropylester; 22-tricosenoic acid 2-hydroxy-3-phosphonooxypropyl ester; 9-tetradecenoic acid 2-hydroxy-3-phosphonooxypropyl ester; 13-eicosenoic acid 2-hydroxy-3-phosphonooxypropyl ester; 10,12-nonacosadiynoic acid 2-hydroxy-3-phosphonooxypropyl ester; 10,12-octadecadiynoic acid 2-hydroxy-3-phosphonooxypropyl ester; 9-octadecanoic acid 2-hydroxy-3-phosphonooxypropyl ester; 10-undecanoic acid 2-hydroxy-3-phosphonooxypropyl ester; 10,12-tricosadiynoic acid 2-hydroxy-3-phosphonooxypropyl ester; 10,12-pentacosadiynoic acid-2-hydroxy-3-phosphonooxypropyl ester; 10,12-heptacosadiynoic acid 2-hydroxy-3-phosphonooxypropyl ester; octanoic acid 2-hydroxy-3-phosphonooxypropylamide; 7-methyloctanoic acid 2-hydroxy-3-phosphonooxypropylamide; 7,7-dimethyloctanoic acid 2-hydroxy-3-phosphonooxypropylamide; nonanoic acid 2-hydroxy-3-phosphonooxypropylamide; 4-methylnonanoic acid 2-hydroxy-3-phosphonooxypropylamide; 8-methylnonanoic acid 2-hydroxy-3-phosphonooxypropylamide; decanoic acid 2-hydroxy-3-phosphonooxypropylamide; undecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 10-methylundecanoic acid 2-hydroxy-3-phosphonooxypropylamide; dodecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 11-methyldodecanoic acid 2-hydroxy-3-phosphonooxypropylamide; tridecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 12-methyltridecanoic acid 2-hydroxy-3-phosphonooxypropylamide; tetradecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 13-methyltetradecanoic acid 2-hydroxy-3-phosphonooxypropylamide; pentadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 14-methylpentadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; hexadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 15-methylhexadecanoic acid 2-hydroxy-3-

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phosphonooxypropylamide; heptadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 16-methylheptadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; octadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 17-methyloctadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; nonadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; 18-methylnonadecanoic acid 2-hydroxy-3-phosphonooxypropylamide; eicosanoic acid 2-hydroxy-3-phosphonooxypropylamide; 19-methyleicosanoic acid 2-hydroxy-3-phosphonooxypropylamide; 19-methyleicosanoic acid 2-hydroxy-3-phosphonooxypropylamide; heneicosanoic acid 2-hydroxy-3-phosphonooxypropylamide; docosanoic acid 2-hydroxy-3-phosphonooxypropylamide; tricosanoic acid 2-hydroxy-3-phosphonooxypropylamide; tetracosanoic acid 2-hydroxy-3-phosphonooxypropylamide; heptacosanoic acid 2-hydroxy-3-phosphonooxypropylamide; octacosanoic acid 2-hydroxy-3-phosphonooxypropylamide; triacontanoic acid 2-hydroxy-3-phosphonooxypropylamide; 6-heptenoic acid 2-hydroxy-3-phosphonooxypropylamide; trans-9-hexadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-11,14,17)-eicosatrienoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-5,8,11,14)-eicosatetraenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-10-heptadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-10-nonadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-3,cis-6-nonadienoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-10-pentadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-12-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-13-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-7-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-8-eicosenoic acid 2-hydroxy-3-phosphonooxypropylamide; trans-9-tetradecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-9,cis-12-octadecadienoic acid 2-hydroxy-3-

phosphonooxypropylamide; trans-9-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-9-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; and (all-trans-9,11,13,15)-octadecatetraenoic acid 2-hydroxy-3-phosphonooxypropylamide. —

-- 24. (Amended) The compound of claim 7 which is selected from the group consisting of (all-cis-9,11,13,15)-octadecatetraenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-11-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-13,16,19)-docosatrienoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-13,16,19)-docosatrienoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-9,12,15)-octadecatrienoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-8,11,14)-eicosatrienoic acid 2-hydroxy-3-phosphonooxypropylamide; trans-11-octadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; trans-13-docosenoic acid 2-hydroxy-3-phosphonooxypropylamide; trans-9,trans-12-octadecadienoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-9-tetradecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-9-hexadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; 10-undecenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-11,cis-14-eicosadienoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-11-eicosenoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-15-tetracosenoic acid 2-hydroxy-3-phosphonooxypropylamide; 11-dodecenoic acid 2-hydroxy-3-phosphonooxypropylamide; 9-decenoic acid 2-hydroxy-3-phosphonooxypropylamide; 16-heptadecenoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-11,14,17)-eicosatrienoic acid 2-hydroxy-3-phosphonooxypropylamide; cis-13-eicosenoic acid 2-

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hydroxy-3-phosphonooxypropylamide; cis-13,cis-13-docosadienoic acid 2-hydroxy-3-phosphonooxypropylamide; (all-cis-7,10,13,16)-docosatetraenoic acid 2-hydroxy-3-phosphonooxypropylamide; 22-tricosenoic acid 2-hydroxy-3-phosphonooxypropylamide; 9-tetradecynoic acid 2-hydroxy-3-phosphonooxypropylamide; 13-eicosenoic acid 2-hydroxy-3-phosphonooxypropylamide; 10,12-nonacosadiynoic acid 2-hydroxy-3-phosphonooxypropylamide; 10,12-nonacosadiynoic acid 2-hydroxy-3-phosphonooxypropylamide; 10,12-octadecadiynoic acid 2-hydroxy-3-phosphonooxypropylamide; 9-octadecynoic acid 2-hydroxy-3-phosphonooxypropylamide; 10-undecynoic acid 2-hydroxy-3-phosphonooxypropylamide; 10,12-tricosadiynoic acid 2-hydroxy-3-phosphonooxypropylamide; 10,12-pentacosadiynoic acid 2-hydroxy-3-phosphonooxypropylamide; and 10,12-heptacosadiynoic acid 2-hydroxy-3-phosphonooxypropylamide. --

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